



BURNHAM.006A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Pellecchia, Maurizio
Appl. No. : 10/686,192
Filed : October 15, 2003
For : USE OF SELECTIVE LABELING
TO DETECT AND
CHARACTERIZE MOLECULAR
INTERACTIONS BY NUCLEAR
MAGNETIC RESONANCE
SPECTROSCOPY
Examiner : Burkhart, Michael D.
Group Art Unit : 1633

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

December 13, 2005

(Date)

Darryl H. Steensma, Reg. No. 43,155

DECLARATION UNDER 37 C.F.R. 1.132

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I, Maurizio Pellecchia, declare and state:

1. I am the inventor of the invention described in the claims of the above-identified application and am familiar with the specification, claims, and prosecution history thereof.
2. I have read the Office Action mailed October 4, 2005, and understand that claims 1-4 are rejected under 35 U.S.C. § 102(a) as being anticipated by Pellecchia et al (Feb. 2002, J. Biomol. NMR). I am the principal author of Pellecchia et al, and the work described therein was done under my direction.
4. I understand that the claims of the above-identified application describe a method involving a selectively labeled target molecule wherein at least a tryptophan moiety is selectively labeled.

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5. I understand that the rejection of claims 1-4 relies on an alleged disclosure in Pellecchia et al of a selectively labeled DHPR bacterial enzyme that is $^{13}\text{C}/^1\text{H}$ labeled at its Met, Ile and Thr residues, and on an alleged disclosure that Trp residues could also be selectively labeled with $^{13}\text{C}/^1\text{H}$.

6. I respectfully submit that Pellecchia et al does not disclose a selectively labeled target molecule wherein at least a tryptophan moiety is selectively labeled. The statement at page 171 of Pellecchia et al that "Selective side-chain $^{13}\text{C}/^1\text{H}$ labeling for the amino acids Val, Tyr, Phe, Trp and His could also be obtained (Goto and Kay, 2000)" is an incorrect statement. Nowhere in the cited Goto and Kay paper is there a description of how selective side-chain $^{13}\text{C}/^1\text{H}$ labeling of Trp could be obtained. There simply is no description of selective Trp labeling anywhere in the Goto and Kay paper. The reference to Trp labeling in Pellecchia et al is a clear error, and that error would be obvious to a skilled worker reading both Pellecchia et al and Goto and Kay.

7. In conclusion, there is no description in Pellecchia et al (or in the combination of Pellecchia et al and Goto and Kay) of a selectively labeled target molecule wherein at least a tryptophan moiety is selectively labeled. In fact, there are no methods disclosed in Pellecchia et al (or in the combination of Pellecchia et al and Goto and Kay) whereby a skilled person could obtain a selectively labeled target molecule, such as DHPR or DOXPR, wherein at least a tryptophan moiety is selectively labeled.

8. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity and/or enforceability of the application and/or any patent issuing therefrom.

Dated: Dec. 5, 2005

By: 

Maurizio Pellecchia

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